

REMARKS

The foregoing amendments are made in connection with Applicant's Request for Continued Examination filed concurrently herewith, and are accompanied by the Declarations of Maasaki Suzuki (in Japanese and a certified translation), Laura Erickson, Lisa Osborne Connolly, Connie Stewart, and Stan Reyes under 37 CFR 1.132. The fee for a one month extension of time is being paid herewith, and constitutes Applicant's request for a one month time extension.

Status of Claims

Claims 1-35 were pending in this application. Claims 1-25 and 29-35 are rejected, and claims 26-28 are allowed. In her Office Action dated March 17, 2009, the Examiner repeated many of her rejections to Applicant's previously submitted claims. Applicant filed a Notice of Appeal on September 16, 2009.

With this paper, claim 1 has been amended and no claims have been canceled. No claims have been added.

The foregoing amendments and the following remarks, and the accompanying declarations, are submitted in response to the Examiner's outstanding Office Action and to seek further reconsideration of this application.

Preliminary Comments

In the following remarks, Applicant will for convenience sometimes refer to a "double comb hair accessory" when referring to a hair accessory having two opposed

combs with elastic elements extending between spines of the combs. In this type of hair accessory the combs can be stretched apart against the restoring force of the elastic elements and rotated downwardly and inwardly so they can be inserted backwards into the hair. The elastic elements will continue to exert a force on the combs when the accessory is worn if the combs are inserted in the hair when the combs are stretched apart. Applicant's invention is directed to a new double comb hair accessory used in this fashion, which is titled Stretch Comb Hair Retainer.

Claim Rejections under 35 U.S.C. §102

1. Claims 1 and 6 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 1,665,380 to Ruffio ("Ruffio").

Claim 1 recites a stretch comb hair retainer comprised of two opposed combs. Each comb has a spine defining the width of the comb and comb teeth projecting from the spine. A stretchable elastic mesh is secured between the spines of the two combs to produce tension between the combs. The elastic mesh has a width comparable to the width of the combs, and is formed by elastic strands extending between the spines of the combs so as to form stretchable openings which can individually be stretched open to allow an amount of the wearer's hair to be pulled through individual openings. Ruffio discloses a woman's headdress that has an "elastic material such as elastic woven fabric" attached between two combs with tufts of hair attached to the front surface of the woven fabric material on "each side of the mid-section" of the fabric. (Ruffio, page

1, lines 58-77.) Ruffio describes the woven fabric material as a "course mesh or net like structure to render the device light in weight and to provide supplementary anchoring means for pinning the hair thereto when forming the coiffure." (Ruffio, page 1, lines 72-76.)

To clarify the invention as recited in claim 1, Applicant previously amended claim 1 to further recite that the elastic strands are capable of being threadedly beaded to provide a decorative elastic mesh. Despite this amendment the Examiner has continued her §102 rejection of claim 1 by simply stating that the Ruffio device is capable of being beaded, without stating how beads could possibly be threaded onto the net-like woven fabric disclosed by Ruffio. (Detailed Action, page 3.) Applicant respectfully submits this would not be possible. It would be like trying to thread beads onto a nylon stocking. Nonetheless, Applicant has further amended claim 1 to still further clarify this distinguishing characteristic of the invention recited in claim 1, namely, that the elastic strands are strung between the spines of the combs and are capable of being threadedly beaded as they are strung from the spine of one comb to the spine of the other comb.

For at least these reasons, it is respectfully submitted that claims 1 and 6 are not anticipated by Ruffio. Applicant therefore respectfully requests that the Examiner's rejection of claims 1 and 6 under 35 U.S.C. 102(b) be withdrawn.

Claim Rejections under 35 U.S.C. §103

1. Claim 32 stands rejected under 35 U.S.C. §103(a) as being unpatentable over USP 6,123,086 (Kuglen) in view of JP #409299131A (JP '131).

Claim 32 recites a stretch comb hair retainer comprising two opposed wire combs, wherein each of the combs has a metal spine defining the width of the comb and a row of looped wires attached to and projecting from the comb's metal spine to form parallel projecting teeth of the comb. This claim further recites that a plurality of elastic strands extend between and are secured at spaced intervals along the spines of the wire combs, and that the elastic strands are strung between the metal spines of the opposed combs so as to form stretchable openings between the elastic strands through which an amount of the wearer's hair can be pulled.

The Section 103 rejection of claim 32 is based on the Examiner's contention that it would have been obvious to one of ordinary skill in the art at the time the invention was made to simply substitute the wire loop comb disclosed by JP '131A for the non-wire combs disclosed in Kuglen. Citing the recent Supreme Court decision in *KSR International Co. V. Teleflex Inc.* 82 USPQ 1385 (2007), the Examiner states that this substitution would produce predictable results.

Unexpected Results

In response, the Applicant submits herewith further declarations under 37 CFR 1.132 to rebut the Examiner's contention that such a substitution would have been

obvious, and as evidence that the results of such a substitution would have been anything but predictable.¹ These further declarations by Maasaki Suzuki, Laura Erickson, Lisa Osborne Connolly, Connie Stewart, and Stan Reyes are in addition to the previously submitted Rule 132 declarations of Karen Giberson and Francesca Kuglen. (The Giberson and Kuglen declarations were filed January 9, 2009.) Taken together, these declarations establish the following:

1. Different types of combs have different characteristics and behave differently in the hair.
2. One type of comb cannot be simply substituted for another type of comb in a particular application with the expectation that the substitution will be useful or will work.
3. Wire loop combs behave much differently in the hair than other types of combs, such as plastic combs.
4. Wire loop combs by themselves do not hold well in the hair and are relatively unstable in the hair.
5. At the time the invention was made, it would not have been predictable that wire loop combs would have worked in a double comb hair accessory.

¹ By offering evidence to rebut the Examiner's obviousness rejections Applicant does not admit that a *prima facie* case of obviousness has been made.

6. At the time the invention was made, the fact that the wire loop combs actually work well to hold a double comb hair accessory in place in the hair was a surprising and unexpected result.

The declarations submitted with this paper reinforce the consumer reactions, previously submitted, to the wire loop combs used in Applicant's Hairzing double comb hair accessory product. See Kuglen 132 Declaration filed January 9, 2009, ¶16, Exhibit B. As one consumer succinctly put it: "Was I surprised when those little bitty wire combs were strong enough to hold all this! I still can't believe it." This consumer was utterly surprised by the ability of the of the wire loop combs (as recited claim 32) to hold the double comb accessory in her hair. Certainly, this consumer reaction suggests that the substitution of wire loop combs for non-wire combs in a double comb hair accessory would not have produced predictable results.

This conclusion is not confined to consumer reactions, but is supported by persons experienced in the art of hair accessory design. Applicant submits herewith the declaration of Mr. Maasaki Suzuki, who is the inventor of the hair ornament disclosed in JP '131A, which is relied upon by the Examiner in support of her rejection of claim 32. Mr. Suzuki, who has owned and operated a hair accessory business in Japan since 1969, states that he would never have thought that his wire loop combs would have

worked in the manner Applicant uses them in a double comb hair accessory. Suzuki Decl., ¶7.

Similarly, declarant, Laurie Erickson, who has been in the hair accessory business for over 20 years and worked with many different types of combs including wire loop combs, states she would not have thought to use wire loop combs for this purpose or predicted that they would have worked in the way Applicant uses them. Erickson Decl, ¶7. A similar disbelief was expressed by declarants Connie Stewart, a designer of Hair accessory products, Stewart Decl. ¶9, and Lisa Osborne Connolly, former Marketing Manager for Goody Products, Inc., Connolly Decl., ¶11.

The surprising and unpredictable results of using wire loop combs in a double comb hair accessory application are explained by Mr. Suzuki and Ms. Erickson in their declarations. First, they point out that different types of combs behave differently in the hair and that simply substituting one type of comb for another type of comb in a particular application is not an obvious thing for a designer to do. Suzuki Decl, ¶11; Erickson Decl, ¶5. Furthermore, wire loop comb are a peculiar type of comb having characteristics much different from other types of combs, such as plastic combs. Suzuki Decl, ¶11; Erickson Decl, ¶5. They are relatively weak compared to other types of combs, such as plastic and wood combs, and when used by themselves tend to slide out of the hair and do not function well to retain or hold hair in place. Suzuki Decl., ¶7; Erickson Decl, ¶5.

Given these characteristics, the fact that two wire loop combs would hold in the hair when pulled on by connecting elastic strands was not something an ordinary hair accessory designer would have predicted. Suzuki Decl., ¶11; Erickson Decl., ¶7. If the ordinary designer had even thought about using wire loop combs in this application, he or she would be motivated to discard this choice of combs because of the comb's peculiar characteristics. The expectation would be that the elastic strands pulling on the combs would pull the combs out of the hair. Suzuki Decl., ¶12; Erickson Decl., ¶7. One notable and unpredictable advantage of using wire loop combs in a double comb hair accessory is that they allow the double comb hair accessory to work well in all volumes of hair. Suzuki Decl., ¶12.

That wire loop combs are not perceived as good holding combs is supported by pull tests commissioned by Applicant performed by a mechanical engineer on two different types of combs: a plastic comb and a wire loop comb. The results of these tests are submitted herewith under the declaration of Stan Reyes. The pull tests on the combs inserted into wefts of human hair demonstrate that the wire loop comb falls out of the hair more easily than plastic combs. This is true for different volumes of hair simulated by using different numbers of hair wefts for the pull tests. As the hair becomes thicker (more wefts) the holding power of plastic combs becomes much greater than wire combs, about five time greater.

With respect to Applicant's showing of unexpected results, it should be noted that

the claimed invention must be compared to the closest prior art before the combination relied upon by the Examiner is made. The Examiner can not require Applicant to compare the combination of elements recited in claim 32 with the combination of the double comb hair accessory disclosed in Kuglen and the wire loop combs disclosed in JP'131 after the combination is made. *In re Chapman*, 148 USPQ 711 (CCPA 1966). To do so would be "[to require a] comparison of the results of the invention with the results of the invention." *Id.* at 714.

Commercial Success

In addition to unexpected results, Applicant offers further evidence of commercial success of Applicant's invention commensurate with the scope of claim 32 (and other claims of the present application). In this case the commercial success is the success of a copy of Applicant's invention. Applicant submits herewith the Declaration of Connie Stewart, who in October 2009 met with the management of Telebrands Corp. and discussed the very successful Telebrands EZ Combs product identified as a copy of Applicant's invention in the previously filed Declaration of Francesca Kuglen. See Kuglen 132 Declaration filed January 9, 2009, ¶¶17-18, Exhibit C8. As revealed by the Stewart declaration, Telebrands had sold seven million EZ Combs as of October 2009 (Stewart Declaration, ¶8), which is a double comb hair accessory that features wire loop combs and which has all the elements of the hair accessory recited in claim 32. EZ Combs is a very successful product for Telebrands. Stewart Declaration, ¶8. It's success in the marketplace and copying by others, coupled by the unexpected results

and advantages of wire loop combs used in such a hair accessory product, provides strong evidence that the use of wire loop combs as recited in claim 32 was not obvious to a person of ordinary in hair accessory design at the time Applicant's invention was made.

Level of Skill in the Art

In addition to providing evidence of unexpected results and commercial success, the declarations of record additionally provide evidence of who the ordinary designer of a hair accessory might be and the level of skill of that designer. As required by *Graham v. John Deere Co.*, 148 USPQ 459 (1966), the level of skill in the art to which the invention pertains must be taken into account in determining obviousness.

In the field of hair accessory design, the declarations submitted herewith establish that the level of skill of the ordinary designer is relatively low. The declarations indicate that hair accessory design is basically a craft business, where the ordinary designer is skilled at making aesthetic changes by putting new ornamental elements onto existing bases, rather than making significant changes to the bases themselves. Suzuki Decl., ¶10; Erickson Decl., ¶4. At the time of the invention, the bases for double comb hair accessories consisted of relatively rigid combs, such as the plastic combs used in the commercial product disclosed in the cited Kuglen reference (USP 6,123,086). Substituting a special purpose wire loop comb for a conventional non-wire comb such as plastic combs amounts to a significant change in the structural characteristics in the base of the double comb hair accessory. The relatively low level of skill in the art

indicated in the declarations submitted herewith and the nature of those skills supports the conclusion that such a substitution would not have been obvious to a person of ordinary skill in the art of hair accessory design. Suzuki Decl., ¶10.

For at least these reasons, Applicant respectfully requests that the Examiner's rejection of claim 32 under 35 U.S.C. 103(a) be withdrawn.

2. Claims 29, 32-35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over USP Design 483,522 (Leslie) in view of Kuglen and JPN '131.

In regards to the Leslie reference, the Declaration of Lisa Osborne Connolly submitted with this paper is, in addition to supporting the non-obviousness of Applicants invention, offered to corroborate the previously submitted 131 Declaration of Francesca Kuglen filed January 9, 2009, to establish a date of invention for Applicant's invention prior to the filing date of the Leslie reference. The Leslie patent application was filed on October 11, 2002. Ms. Connolly, who worked at Goody Products between October 2000 and February 2003, received from Ms. Kuglen samples of the beaded double comb hair accessory product disclosed in this application. These samples used wire loop combs. While Ms. Connolly's recollections of events cannot precisely pinpoint the date she first saw these samples she does recollect it was no later than February 2002. It could have been as early as February 2001. In either event, Ms. Connolly's detailed recollections, taken together with the prior 131 Declaration of Ms. Kuglen, support a date of invention well before the Leslie filing date of October 11, 2002. Therefore, Applicant submits that

Leslie is not prior art to Applicant's invention and should be withdrawn as a reference.

Even if Leslie is considered to be prior art, it would not have been obvious to combine the wire loop comb disclosed in JP '131 with Leslie for the reasons discussed above in connection with claim 32. Neither Leslie, a design patent that shows opposed non-wire combs connected by parallel beaded strands, nor JP '131 in any way suggest such a combination. Indeed, Mr. Maasaki Suzuki, the inventor of the hair ornament disclosed in JP '131, unequivocally states that he would have never considered using wire loop combs in a double comb hair accessory. Suzuki Decl., ¶8.

Applicant therefore respectfully requests that the Examiner's rejection of claims 29, 32-35 under 35 U.S.C. 103(a) be withdrawn.

3. Claims 1-25, 30 and 31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Leslie in view of Kuglen and JPN '131 as applied to claim 32, and further in view of U.S. Patent No. 1,564,079 ("Lorbiecki").

As discussed above, Leslie should be withdrawn as a reference in view of the Rule 131 Declarations of Francesca Kuglen and Lisa Osborne Connolly.

Whether or not Leslie is considered, Applicant submits that the Examiner's reliance on Lorbiecki as disclosing an elastic mesh as recited in claims 1-25, 30 and 31 is misplaced. Lorbiecki discloses a common hair net for covering the entire head. The net of Lorbiecki is created by crossed threads (3,4). Lorbiecki does not disclose a mesh created by elastic strands as recited in claims 1-25, 30 and 31, and does not suggest the

use of a stretchable elastic material for the threads that make up the net. Lorbiecki also fails to disclose or suggest the use of a mesh extending between opposed combs wherein the width of the mesh is comparable to the width of the combs, as recited in independent claims 1 and 15, or is about the same as the width of the combs as recited in independent claim 21.

With respect to claims 2, 20, 30 and 31, which recite, or whose base claim recites, that the opposed combs are wire loop combs, it would not have been obvious to combine the wire loop comb disclosed in JP '131 with Leslie or Kuglen for the reasons discussed above in connection with claim 32. Neither Leslie nor Kuglen disclose or suggest the use of wire loop combs in the combination recited in claims 2 and 20.

For at least the foregoing reasons, Applicant respectfully requests that the Examiner's rejection of claims 1-25, 30 and 31 under 35 U.S.C. 103(a) be withdrawn.

Conclusion

In view of the foregoing amendments and remarks, Applicant submits that the present application is in condition for allowance, a request for which is hereby respectfully made.

Date: December 10, 2009

Respectfully Submitted,

/Donald L. Beeson/
Reg. No. 27,692
BEESON SKINNER BEVERLY, LLP
One Kaiser Plaza, Suite 750
Oakland, California 94612
Tel: 510-832-8700
Fax: 510-836-2595
email: bsb@bsbllp.com